



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,971	07/28/2003	Michael Biggs	P-003-000	7121

36544 7590 01/26/2005

BRNCUS TECHNOLOGIES, INC.
BUILDING A8
1400 N. SHORELINE BLVD.
MOUNTAIN VIEW, CA 94043

EXAMINER

JACKSON, GARY

ART UNIT PAPER NUMBER

3731

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/628,971	Applicant(s) BIGGS ET AL.	
	Examiner Gary Jackson	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/22/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

AG

DETAILED ACTION***Double Patenting***

Claims 1 and 15-20 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,599,311 and claim 1 of U.S. Patent 6,174,323 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant patent application is fully disclosed in the patents and is covered by the patents since the patents and application are claiming common subject matter, as follow: A method of lung volume reduction comprising: advancing an anchor into a passage of the lung; inserting the anchor into tissue attaching a line to the anchor; and reducing a volume of a portion of the lung by drawing upon the line. The allowance of this claim would extend the rights to exclude already granted in the claims 1 of the patents – that right to exclude covering a lung volume reduction device comprising: a) at least one anchor having a reduced profile and being configured to assume an expanded profile wherein in said reduced profile said anchor is capable of being advanced into an airway of the lung and in said expanded profile said anchor secures to lung tissue; b) at least one connector; c) at least one cord having a proximal end and a distal end, said proximal end being attached to at least one of said connectors which is adapted to be self-locking about said cord and said distal end being attached to at least one of said anchors; and d) a delivery device being configured to removably seat at least one of said anchors on a distal end. Also covering a method for compressing the volume of a portion of a lung, the method comprising: anchoring a first anchor at a first position in the lung; anchoring a second anchor at a second position in the lung, the first position being distant from the second

Art Unit: 3731

position; reducing the distance between the anchored first anchor and the anchored second anchor; and preventing the reduced distance from substantially increasing.

The transitional phrase "comprising" does not exclude the presence of elements other than a method of lung volume reduction comprising: advancing an anchor into a passage of the lung; inserting the anchor into tissue attaching a line to the anchor; and reducing a volume of a portion of the lung by drawing upon the line. Because of the phrase "comprising" the patent claim not only provides protection to the above method but also extends patent coverage to the disclosed method of lung volume reduction as claimed in the present application. Thus the controlling fact is that the patent protection for the method fully disclosed and covered by the claims of the patent would be extended by the allowance of the claim in this application.

Claims 2-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,599,311. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of promoting tissue growth, utilizing bioabsorbable anchors and inserting a valve into an airway are well known in the art. It would have been obvious to one having ordinary skill in the art to modify the above patent with the known techniques to promote healing in the lung.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3731

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (571) 272-4697. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Antoine Nguyen can be reached on (571) 272-4693. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Jackson
Primary Examiner
Art Unit 3731



gj
January 24, 2005